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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,242	12/09/2003	Brian Jones	60001.296US01	4899

27488 7590 01/23/2009

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EXAMINER	
TSUI, WILSON W	
ART UNIT	PAPER NUMBER
2178	
MAIL DATE	DELIVERY MODE
01/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/731,242	JONES ET AL.	
	Examiner	Art Unit	
	WILSON TSUI	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,6-12,14 and 16-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,6-12,14 and 16-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20081028*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This non-final action is in response to the RCE filed on: 10/27/08, and IDS filed on: 10/28/08.

2. Claims 1, 10, 18, 19, and 21 are amended. Claims 2-5, 13, and 15 are cancelled. Claims 1, 10, and 18 are independent claims. Thus, claims 1, 6-12, 14, and 16-22 are pending.

3. The following rejections are withdrawn, in view of new grounds of rejection necessitated by applicant's amendments:

- Claims 1, 6-8, 10, 12, 14, and 16-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Altamura et al in view of Sun Micro, and further in view of Eisenberg.
- Claim 9, 11, and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Altamura et al, Sun Micro, Eisenberg, and further view of Pavlov.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 10/28/08 is being considered by the examiner.

Specification

5. The disclosure is objected to because of the following informalities: The related application # in the 1st page of applicant's specification should be updated.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10-12, 14, 16, and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regards Claim 10, the claimed “computer readable medium”, which is defined in the specification of the invention as including communication media that can be embodied in a data signal or carrier wave. Because carrier waves, being a form of electromagnetic energy, do not fall into one of the statutory categories of 35 U.S.C. 101, the claim includes non-statutory subject matter. A detailed explanation describing why carrier waves are regarded as non-statutory subject matter under 35 U.S.C. 101 follows:

> Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O’Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.
>
> First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.
>
> "The term machine includes every mechanical device or combination of mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result." Corning v. Burden, 56 U.S.

(15 How.) 252, 267 (1854). A modern definition of machine would no doubt include electronic devices which perform functions. Indeed, devices such as flip-flops and computers are referred to in computer science as sequential machines. A claimed signal has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances and includes all composite articles, whether they be results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." Shell Development Co. v. Watson, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), aff'd, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See American Disappearing Bed Co. v. Arnaelsteen, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. Lorillard v. Pons, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in American Fruit Growers when it passed the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, § 1.02[3] (citing W. Robinson, The Law of Patents for Useful Inventions 270 (1890)).

A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

With regards to claims 11, 12, 14, 16, and 17, they are rejected under similar rationale as the rejection for claim 10 above, since they do not remedy the deficiencies of claim 10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 6-8, 10, 12, 14, and 16-21 are currently rejected under 35 U.S.C. 103(a) as being unpatentable over Altamura et al (IJDAR, published: November 7, 2000, pages 6-12) in view of Sun Micro ("Star Office XML File Format Working Draft", pages 19, 48, 49, 51, 54-58, 89, 142, and 234, published: January 2001), and further in view of Eisenberg (XML.com, published, June 8, 2001, pages 1a and 1), and further in view of Jelliffe ("Weak Validation", publisher: Academia Sinica Computing Centre, published: July 1999, pages: 1-4).

With regards to claim 1, Altamura et al teaches a method comprising:

- *Determining properties corresponding to a mini-document that relates to at least one section of a word processing application document generated on a word processing application, the mini-document includes a body portion:* (Fig. 3, P6-5: whereas, layout analysis is performed to determine the properties for each block in a document (where each block relates to a segment of a document image, and thus represents a mini-document of the entire application document)). … wherein the mini-document includes at least one member of a group comprising a header

(P9-3, whereas, a mini-document is recognized to be a header (labeled as 'running-header'). Additionally, the mini-document has a body section, the body section comprises text such as the title of a header, as shown enclosed between the '<running-header>' and '</running-header>' markup, in P9-3. Furthermore, P9-4: whereas, the image document is word processed since OCR technology is used to extract words from the image, and thus represents a word processing document as well).

- *Mapping the properties of the mini-document into a markup language element*: (P9-3: whereas, the properties of the mini-document, such as a running-header, is mapped into an element (labeled 'ID'), and assigned an ID value such as 'id0').
- *Storing each of the section properties of the mini-document in the markup language document*: (P8-1 and P9-3: whereas, the properties are stored in a DTD data file).
- *Validating the markup language document in accordance with a native schema of the word processing application having definitions for the mini-document, wherein the definitions for the mini-document include a definition for headers, and a definition for a mini-document type* (P7-10: whereas, the markup language document is validated according to a DTD/schema to conform to a set of logical document structure rules).

However, Altamura et al does not expressly teach wherein the mapping properties includes: *setting an option element in the mini-document markup language element,*

wherein the option element includes at least one member of a group comprising: a header value and a footer value, *setting a type attribute in the mini-document markup language element, wherein the type attribute includes a value that indicates an occurrence* pattern of the body of the mini-document within the application document; , *setting page size properties of the application document in the section properties of the application document, wherein the page size properties includes a size value of the page, and setting a margin properties of the application document in the section properties of the application document, wherein the margin properties include a top margin value, a bottom margin value, a left margin value, a right margin value and a position value of the location of the mini-document within the section of the application document;* and wherein the definition for the mini document includes *a definition for a footers, a definition for a context free chunk, a definition for a paragraph element, a definition for a table element; and wherein the application other than the word processing application does not have access to the native schema of the word processing application having the definitions of the document.*

Sun Micro teaches wherein *mapping and rendering the properties of the mini-document markup language element that is stored with each of the markup language section properties of the application document, wherein mapping and rendering the properties includes: setting and rendering an option element in the mini-document markup language element, wherein the* option element (pages 48 and 49: whereas section properties of an application/word-processing document is set through the use of a

master page style element, and also page master element) *includes at least one member of a group comprising: a header value and a footer value* (pages 54-58: whereas the option element includes a header and a footer value), setting and rendering *the type attribute includes a value that indicates an occurrence* pattern of the body of the mini-document within the application document; (page 89, whereas, a horizontal type attribute corresponds to an occurrence pattern of a mini-document/frame)*, setting and rendering page size properties of the application document in the section properties of the application document, wherein the page size properties includes a size value of the page* (page 49)*, and setting and rendering margin properties of the application document in the section properties of the application document, wherein the margin properties include a top margin value, a bottom margin value, a left margin value, a right margin value* (page 51) *and a position value of the location of the mini-document within the section of the application document* (page 89, whereas, a horizontal type attribute corresponds to an occurrence pattern of a mini-document/frame)*, wherein mapping includes mapping the properties into at least one member of a group comprising: a context free chunk element* (whereas, properties of an application word processing document are analyzed to determine the properties of different sections including *table element properties* (page 9: whereas, an application word processing document gets analyzed, such that the properties are stored in XML format, and page 234, wherein table properties of a word document, include table elements to describe a particular table in an application document), and including *paragraph element* (page 51: whereas margins are part of paragraph formatting

properties). Additionally, as explained in page 142, *whereas a footnote body includes a context free chunk element* by implementing inline data.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al's method for determining and defining properties corresponding to a mini-document, to have further included and defined a mapping type attribute that corresponds to an occurrence pattern, and mapping the properties into a context free chunk element. The combination of Altamura et al and Sun Micro would have allowed Altamura et al to have implemented an "open standard for office documents" (Sun Micro, page 19).

However, Altamura et al and Sun Micro do not expressly teach *the type attribute causes the body portion of the mini-document to be repeated in the application in accordance with the occurrence pattern,* and *wherein the value is at least one member of a group comprising: an odd page value and an even page value, and wherein the application other than the word processing application does not have access to the native schema of the word processing application having the definitions of the document*.

Yet, Eisenberg teaches wherein the type attribute *causes* a document type *to be repeated in the application document in accordance with the occurrence pattern indicated by the type attribute (*whether pages *correspond to even, or odd number* pages of a document (P1-4), as well as a *first page* (P1-2: whereas, a cover page is a sequence of one page).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al's type attribute for whether a document (such as a mini-document comprising a body) occurs on a first, even, or odd pages as taught by Eisenberg. The combination of Altamura et al, Sun Micro, and Eisenberg would have allowed Altamura et al's system to have "specified the order (of pages) when it was the time to generate a sequence of pages" (Eisenberg, P1-1), and to also have optimally described the occurrence of a sub/mini-document, should the sub/mini-document be common among a set of pages in an application document.

However, although the combination of Altamura et al, Sun Micro, and Eisenberg teaches:

> Parsing and rendering the markup language document on an application other than the word processing application, and the option element in the section properties causes the rendering of at least one member of a group comprising a header according to the header value for the section, and a footer according to the footer value for the section, wherein the type attribute in the section properties causes the body portion of the mini-document to be rendered in accordance with the occurrence pattern of the section, wherein the value is at least one member of a group comprising: an odd page value for the section and an even page value for the section, wherein the page properties for the section causes the page to be rendered according to the size value of the page of the section, and margin properties for the

section causes the rendering of a top margin according to the top margin value, a bottom margin according to the bottom margin value, a left margin according to the left margin value, a right margin according to a right margin value and a mini-document position according to the position value of the location of the mini-document within the section, as explained above.

The combination of Altamura et al, Sun Micro, an Eisenberg does not expressly teach *wherein the application other than the word processing application does not have access to the native schema of the word processing application having the definitions of the document*.

Yet, Jelliffe teaches *wherein the application other than the word processing application does not have access to the native schema of the word processing application having the definitions of the document* (page 2: whereas flexible schemas/DTD can be implemented and accepted with as much validity as possible, as the case with the XML document moved into word processors).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al, Sun Micro, and Eisenberg's word processing application, such that applications can flexibly accept a schema, as taught by Jelliffe. The combination of Altamura et al, Sun Micro, Eisenberg, and Jelliffe would have

allowed Altamura et al to have "implemented a very useful form of validation for implementers of software that accepts XML " (Jelliffe, page 2).

With regards to claim 6, which depends on claim 1, Altamura et al teaches a method wherein:

- *Determining the properties corresponding to an additional mini-document that relates to at least one section of the application document*: (Fig. 3, p6-5: whereas, layout analysis is performed to determine one or more additional mini documents/blocks that have like properties in a document).
- *Mapping the properties of the additional mini-document into a markup language element,* an attribute and a value: (P9-3: whereas, the properties of the additional mini-document, such as a running-header, is mapped into an element (labeled 'ID'), and assigned an ID value such as 'id0' for one type of mini-document, and 'id4' for another type of mini document).
- *Storing the properties of the mini-document in the markup language document*: (P8-1 and P9-3: whereas, the properties are stored in a DTD data file).

Additionally, Sun Micro teaches wherein *mapping includes mapping the properties into at least one member of a group comprising*: *a table element*, as similarly explained in the rejection for claim 1, and is rejected under the same rationale.

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al's method for determining properties corresponding to an additional mini-document, to have further included determining the properties comprise at least one of a table element, as taught by Sun Micro. The combination of Altamura et al, Sun Micro, Eisenberg, and Jelliffe would have allowed Altamura et al to have implemented an "open standard for office documents" (Sun Micro, page 19).

With regards to claim 7, which is dependent on claim 1, Altamura et al teaches a method comprising:

- *Determining whether properties associated with all mini-documents of the application document have been stored in the markup language document; and processing further mini-documents when the properties associated with all mini-documents have not been stored in the markup language document* (P7-9: whereas, the application document is translated into HTML/XML formats by aggregating all textual, graphical, layout and logical information extracted in the document analysis and understanding process).

With regards to claim 8, which is dependent on claim 1, Altamura et al teaches a method wherein *the properties of the mini-document stored in the markup language document* (in claim 1, and is rejected under the same rationale), *are understood by an application that understands the markup language when the mini-document is not native*

to the application (P7-10, Fig. 5: whereas, xml documents can be sent to a client browser that does not have the mini-document native to the application, through the help of a validating parser using an agreed schema of information exchange (DTD) + XML)).

With regards to claim 10, Altamura et al teaches a computer readable medium comprising:

- *Determining properties relating to a mini-document, wherein the mini-document includes a body portion having text* (similar to claim 1, and is rejected under the same rationale) *used within a word processing document, generated on a word processing application* (P9-4: whereas, the image document is word processed since OCR technology is used to extract words from the image, and thus represents a word processing document as well).
- *Determining whether the mini-document is at least one member of a group comprising a header* (P9-3, whereas, a mini-document is recognized to be a header (labeled as 'running-header').
- *Writing the properties into at least one of a markup language element,* an attribute, and a value, similarly in claim 1, and is rejected under the same rationale.
- *Storing the properties in the markup language document such that the headers of the word-processing document are substantially maintained when the markup*

language document is parsed by an application (P8-1 and P9-3: whereas, the properties are stored in a DTD data file).f

- *Validating the markup language document in accordance with a native schema of the word processing application having definitions for the mini-document* (P7-10: whereas, the markup language document is validated according to a DTD/schema to conform to a set of logical document structure rules).

However, Altamura et al does not expressly teach writing the properties into *each of the section properties markup language elements associated with the word processing document, wherein writing the properties includes: writing an option element in the mini-document markup language element, wherein the option element includes at least one member of a group comprising: a header value and a footer value, setting a type attribute, wherein the type attribute includes a value that indicates an occurrence pattern of the body of the mini-document in the application document wherein upon rendering the markup language document, the type attribute causes the body portion of the mini-document to be repeated in the application in accordance with the occurrence pattern, and setting a margin properties of the application document in the section properties of the application document, wherein the margin properties include a numerical position value of the location of the min-document within the section of the word-processing document; storing the properties in the markup language document.*

Altamura, Sun Micro, and Eisenberg similarly teach writing the properties into *each of the section properties markup language elements associated with the word processing document, wherein writing the properties includes: writing an option element in the mini-document markup language element, wherein the option element includes at least one member of a group comprising: a header value and a footer value, setting a type attribute, wherein the type attribute includes a value that indicates an occurrence pattern of the body of the mini-document in the application document wherein upon rendering the markup language document, the type attribute causes the body portion of the mini-document to be repeated in the application in accordance with the occurrence pattern, and setting a margin properties of the application document in the section properties of the application document, wherein the margin properties include a numerical position value of the location of the min-document within the section of the word-processing document; storing the properties in the markup language document such that the headers and footers of the word-processing document are substantially maintained when the markup langue document is parsed by an application,*(as similarly explained in the rejection for claim 1), and is rejected under similar rationale.

However, although the combination of Altamura et al, Sun Micro, and Eisenberg teaches *parsing and rendering the markup language document on an application other than the word processing application, ... wherin the markup language document is rendered according to the properties written to the section properties markup language elements,* as explained above; the combination of Altamura et al, Sun Micro, an

Eisenberg do not expressly teach *wherein the application other than the word processing application does not have access to the native schema of the word processing application having the definitions of the mini-document*.

Yet, Jelliffe teaches *wherein the application other than the word processing application does not have access to the native schema of the word processing application having the definitions of the document* (page 2: whereas flexible schemas/DTD can be implemented and accepted with as much validity as possible, as the case with the XML document moved into word processors).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al, Sun Micro, and Eisenberg's word processing application for rendering according to specific properties, such that applications can flexibly accept a schema, as taught by Jelliffe. The combination of Altamura et al, Sun Micro, Eisenberg, and Jelliffe would have allowed Altamura et al to have "implemented a very useful form of validation for implementers of software that accepts XML " (Jelliffe, page 2).

With regards to claim 12, which depends on claim 10, Altamura et al teaches a computer readable medium for performing a method similar to claim 8, and is rejected under the same rationale.

With regards to claim 14, which depends on claim 10, Altamura et al teaches a method for a *mini-document occurring in a specified section of the word processing document* (in claim 10, and is rejected under the same rationale), and a *type attribute*, similarly in claim 3, and is rejected under the same rationale.

However, Altamura et al does not expressly teach the type attribute corresponding to *whether* the mini-document *occurs on at least one member of a group comprising: odd pages of a specified section of the application document, or even pages of the application document*.

Yet, Altamura et al, Sun Micro, Eisenberg, and Jelliffe teaches the *attributes* for whether the mini document *corresponds to whether the mini-document occurs on at least one member of a group comprising odd pages of the specified section of the application document, or even pages of the specified section of the application document,* as similarly explained in the rejection for claim 10, and is rejected under similar rationale.

With regards to claim 16, which depends on claim 10, Altamura et al teaches a computer readable medium comprises:

- *Determining properties corresponding to an additional mini-document that relates to at least one section* (similarly in claim 6, and is rejected under the same rationale), *of a word processing document* (in claim 10, and is rejected under the same rationale).

- *Mapping the properties of the additional mini-document into at least one of a markup language element,* an attribute, and a value*; and storing the properties of the additional mini-document in the markup language document*: (as similarly taught in claim 6, and is rejected under the same rationale).

Additionally, the combination of Altamura, Sun Micro, Eisenberg, and Jelliffe teach *wherein the mapping includes mapping the properties into at least one member of a group comprising*: *a table element*, as similarly explained in the rejection for claim 10, and is rejected under the same rationale.

With regards to claim 17, which depends on claim 10, Altamura et al teaches a computer readable medium for performing a method similar to claim 7, and is rejected under the same rationale.

With regards to claim 18, Altamura et al, Sun Micro, Eisenberg, and Jelliffe teaches a system a processor and memory associated with computer-executable instructions configured to:

- *Determine properties relating to a mini-document included in at least one section of a word processing application document generated on a word processor, wherein the mini-document includes a body portion having text; determine whether the mini-document is at least one member of a group comprising: a header and a footer; map the properties into a markup language element that is stored with markup language section properties of the sections of the application*

document, wherein mapping the properties includes setting an option element in the mini-document markup language element, wherein the option element includes at least one member of a group comprising: a header value and a footer value, setting a type attribute, wherein the type attribute, includes a value that indicates an occurrence pattern of the body of the mini-document within the application document, , setting a margin properties of the application document in the section properties of the application document, wherein the margin properties include a position value of the location of the mini-document within the section of the application document, and store the properties in the markup language section properties of the application document; and a validation engine configured to validate the markup language document; and an application other than the word processing application, wherein the application other than the word processing application does not have access to the native schema of the word processing application having the definitions of the mini-document, wherein the markup language document is parsed and rendered by the application other than the word processing application according to the properties written to the section properties markup language elements (as similarly explained in the rejection for claim 1), and is rejected under similar rationale.

With regards to claim 19, which depends on claim 18, Altamura et al teaches a system performing a method similar to claim 6, and is rejected under the same rationale.

With regards to claim 20, which depends on claim 18, Altamura et al teaches a system performing a method similar to claim 7, and is rejected under the same rationale.

With regards to claim 21, which depends on claim 18, Altamura et al teaches a system wherein *the properties of the mini-document stored in the markup language document are understood by the other than the word processing application that understands the markup language when the mini-document is not native to the application other than the word processing application*, as similarly explained in claim 10, and is rejected under similar rationale.

8. Claims 9, 11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altamura et al (IJDAR, published: November 7, 2000, pages 6-12), Sun Micro ("Star Office XML File Format Working Draft", pages 19, 48, 49, 51, 54-58, 89, 142, and 234, published: January 2001), Eisenberg (XML.com, published, June 8, 2001, pages 1a and 1), and further in view of Jelliffe ("Weak Validation", publisher: Academia Sinica Computing Centre, published: July 1999, pages: 1-4), and further view of Pavlov (US Patent: 6,725,426 B1, published: Apr. 20, 2004, filed: Mar. 17, 2000).

With regards to claim 9, which is dependent on claim 1, Altamura et al teaches a method for wherein *the markup language document is manipulated* on a client station *to*

substantially reproduce the mini-document of the application document not withstanding the presence of an application that generated the markup language document (Section 6.2, Fig. 5: whereas, the properties stored in the markup document, are understood by a client web browser to reproduce the document without using WISDOM++).

However Altamura et al does not teach the markup language document is *manipulated on a server* to reproduce the mini-document.

Pavlov teaches a markup language document is *manipulated on a server to reproduce the mini-document* (column 3, lines 59-65: whereas, a system capable of retrieving XML content is manipulated by a server to reproduce a document for a particular device).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Altamura et al's mini-document reproduction system to be reproduced on a server system as taught by Pavlov. The combination of Altamura et al, Sun Micro, Eisenberg, Jelliffe, and Pavlov would have allowed Altamura et al's system to have "stored content in XML format instead of word processing documents" (Pavlov, column 1, lines 34-39).

With regards to claim 11, which depends on claim 10, Altamura et al a computer readable medium comprising:

- A *word processing document,* similarly, in claim 10, and is rejected under the same rationale.
- *The markup language document is manipulated* on a client *to substantially reproduce the mini-document of the word-processing document not withstanding the presence of an application that generated the markup language document* (Section 6.2, Fig. 5: whereas, the properties stored in the markup document, are understood by a client web browser to reproduce the document without using WISDOM++). However Altamura et al does not teach the markup language document is *manipulated on a server to reproduce the mini-document*.

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to have “stored content in XML format instead of word processing documents” (Pavlov, column 1, lines 34-39).

With regards to claim 22, which depends on claim 18, Altamura et al teaches a system performing a method similar to claim 9, and is rejected under the same rationale.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 6-12, 14, 16-22 have been considered but are moot in view of the new ground(s) of rejection.

10. Additionally, the examiner points out that the applicant is arguing particular limitations are not taught throughout pages 11-18 of applicant remarks, but does not explain or provide support as to why the limitations are not taught. Thus, these arguments are not persuasive, and the examiner respectfully directs the applicant to the rejections above, with respect to how the previous and newly amended limitations are taught using the combination of Sun Micro, Eisenberg, and Jelliffe.

11. Additionally, the Examiner would like invite the applicant for an interview to recommend a few things with regards to the limitations of claim 1, that would help expedite the prosecution of the application for possible allowance (more specifically, the limitations with regards to mapping the properties of the mini document).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CESAR B PAULA/
Primary Examiner, Art Unit 2178

/Wilson Tsui/
Patent Examiner
Art Unit: 2178
January 5, 2009